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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,701	06/01/2001	Steven W. Lundberg	296.022US1	2505

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. BOX 2938  
MINNEAPOLIS, MN 55402

EXAMINER

AMSBURY, WAYNE P

ART UNIT PAPER NUMBER

2161

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/872,701

Applicant(s)

LUNDBERG, STEVEN W.

Examiner

Wayne Amsbury

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

CLAIMS 1-96 ARE PENDING

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Applicant's arguments filed 10/4/04 have been fully considered but they are not persuasive.

Applicant makes a number of assertions with which the examiner respectfully disagrees:

*Leedom fails to recite generation of docket data within the system such that the docket data is based on patent laws and rules governing patent prosecution, but teaches only entry and verification of human operator determined and verified docket data.*

Leedom teaches that there are a large number of deadlines associated with patent dockets and that they are based on patent laws [COL 1 lines 25-60]. Leedom then teaches the automatic generation of such data based on (user) entry of related information [COL 3 lines 27-554]. It is noted that the Specification of this application is clearly intended as an improvement on *paper-based systems* [pages 1-2], not systems with automatic determination of deadlines based on laws and rules as Leedom clearly is by evidence of the background [cited above in part].

Further, there is no basis in the Specification of this application for task lists and the like that are not ultimately based on human data entry in some form, very much in conformity with Leedom. Leedom is directed particularly to user *verification* of docket data generated in response to related data entries [COL 3 line 66 to COL 4 line 16] in order to improve its reliability.

*None of the cited portions of Leedom recite managing tasks ... or automatic generation within the system of tasks to be completed related to the managed matters.*

Clearly, this is accomplished in the background of Leedom as noted above. In particular, note COL 3 line 28, *(7) multi tasking and "windows" capabilities*. It is difficult to avoid this conclusion in any reading of Leedom. The basic task in the docket of Leedom is to respond to deadlines based on laws and rules [COL 2 line 66 to COL 3 line 28].

*Leedom further fails to consider a security module as is recited in the pending claims. Leedom fails to discuss limiting access to task and matter data, and fails to consider doing so in the context of the Internet.*

The rejection included a rejection of the security aspect of the claims [rejection of 6/28/04 pages 2-3], where networking and an obviousness statement related to the Internet based purely on Leedom is to be found. Applicant does not dispute this statement.

The objection to Grow, US 6,694,315 are not directly related to the application of Grow in the rejection of the claims, where Grow is used to provide the teaching of the use of the Internet in the context of Leedom as an adjunct to the (undisputed) obvious use within the context of Leedom. The statement of combination for Leedom and Grow is also not disputed by Applicant. Thus both statements stand, and either will serve as a rejection of the Internet aspect of the claims.

**The rejections below are incorporated by reference from the previous action, but are included in their entirety in the interest of compact prosecution.**

**3. Claims 1-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leedom, Jr. (Leedom), US 5,329,447, 12 July 1994 in light of Grow, US 6,694,315, 17 February 2004.**

Leedom is directed to a computer implemented docketing system with application to US patents in the context of Patent Laws [BACKGROUND].

As to **claim 1**, Leedom teaches the use of a docketing system for patent cases [COL 5 lines 42-57 and elsewhere], which corresponds to the matter module of the claim. The generation of docketing data based on patent laws and rules governing prosecution is addressed in the BACKGROUND as noted above, and in various specific instances such as COL 4 lines 53-62. The tasks module of the claim corresponds to various means of the system, such as those listed in the SUMMARY. The need for

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security is inherent in patent prosecution, as information in an application file is restricted until published.

Leedom is envisioned as being supported by a network that is not specifically the Internet [COL 7 lines 22-42], but security is imposed even in this environment [COL 7 lines 54-60 and elsewhere].

The limitation of claim 1 that ties the Internet to the other claim limitations arises from the security considerations, since the Internet is public, but as noted in the citation above, "public" vs. restricted is an aspect of a patent docketing system even in a LAN environment.

Leedom has a presumed invention date on or before 12 March 1992, and it **would have been obvious** to one of ordinary skill in the art at the time of the invention to provide for Internet access because of the expansion, convenience, and efficiency of the Internet since that date. However, since Leedom does not explicitly provide for an Internet embodiment, in the interest of compact prosecution evidence that it would be obvious to do so is provided as follows.

One of the objects of Grow is to provide for online management of documents with associated deadlines [COL 1 lines 34-43; COL 2 lines 7-9], while addressing the security requirement of that environment [COL 2 lines 9-12]. **It would have been obvious** to one of ordinary skill in the art at the time of the invention to combine the online capability of Grow with the system of Leedom in order to fill the need for online document assembly and docketing or calendaring [Grow COL 1 lines 44-47].

The further limitations of **claims 2-24** are housekeeping details either inherent in the embodiment of the general objects of Leedom set forth in COL 4-6 and in Grow COL 1-2 or alternately **would have been obvious** to one of ordinary skill in the art at the time of the invention as providing efficient and complete support to those general objects. However, in the interest of compact prosecution, the teachings of Leedom and Grow that relate to claims 2-24 are set forth as follows.

As to **claims 2-3**, patent matter data must be created in order to be in the database, and retrieved in order to be of use to a user [SUMMARY, both Leedom and Grow]. As to **claim 4**, editing of such matter was noted as prior art as of 5/12/1992 in Leedom, and is noted as an update operation in Grow [COL 2 lines 22-23]. As to claims 5-6, Leedom lists a variety of created tasks [SUMMARY] and Grow is explicit about assembly and notification [SUMMARY]; some are created automatically and some by the user.

As to **claims 7-11**, Leedom is explicit about relating matters and tasks to designated users, grouped by practitioner, patent numbers, patent cases and so on [SUMMARY]. The Table of Contents at least of Leedom provides a human operator controlled calendar of tasks [COL 6 lines 6-16].

As to **claims 12-17**, the use of *login* is implied by the use of (*username, password*) at COL 8 of Grow, and Grow specifies a *log off* [COL 9 lines 37-46] and *log on* [COL 13 lines 917]. The use of email and messaging are such ubiquitous components of the Internet that they do not require explicit mention for one of ordinary

skill in the art to find their application obvious, but Grow is explicit about their use at COL 13 lines 9-24 and elsewhere.

As to claims **18-21**, see FIG 1 of Grow and elsewhere.

As to **claims 22-24**, it is clear in Grow that the transmittal of attorney work products and the like between user terminals and the website that may comprise multiple computers involves multiple databases [SUMMARY; COL 3 Overview].

The elements of **claims 25-96** are rejected in the analysis above and these claims are rejected on that basis.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 571-272-4015. The examiner can normally be reached on M-F 6-18:30 FIRST WEEK.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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WPA

  
WAYNE AMSBURY  
PRIMARY PATENT EXAMINER